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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,563	10/23/2003	Frederic Legrand	05725.1255-00	6452
22852	7590	02/09/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
MAIL DATE		DELIVERY MODE		
02/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/690,563

Applicant(s)

LEGRAND, FREDERIC

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 1/9/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of IDS and remarks filed on 1/9/09.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/09 has been entered.

Claims 1-71 are pending in the application. Claims 60-71 have been withdrawn from consideration as being drawn to non-elected subject matter. Claims 1-59 are currently examined in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-24 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-24 lacks antecedent basis with respect to "cross linked and non-cross linked". Note that these claims depend on claim 12 and claim 12 depends on claim 1. Claims 26-27 lacks antecedent basis with respect to "r".

Response to Arguments

Applicant's arguments with respect to claims 1-59 rejected under 103 over the combination of U.S. Patent No. 4,927,627 ('627), U.S. Patent No. 6,645,476 ('476), and U.S. Patent No. 6,180,118 ('118). have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WO 02/051,369 ('369) and U.S. Patent 4,927, 627 ('627).

The examiner is relying on English equivalent of WO document, which is PGPUB US 2004/0074015 ('015). Applicant's submitted certified English translation of foreign priority document on 10/29/07. The publication date of WO document is July 4, 2002 and this date is before the effective filing date of the instant application, which is October 23, 2002.

PGPUB '015 teaches oxidizing compositions using claimed cross-linked amphilic polymer and claimed hydrophobic unit. See paragraphs 27-88 for detailed description of the claimed amphilic polymer and claimed hydrophobic unit (claims 2-16). See paragraphs for detailed description of the oxidizing agent and see paragraph 97 for the claimed stabilizer, see paragraphs 218-220 for anionic and non-ionic surfactants.

PGPUB teaches the limitations of claims 17-22 at paragraphs [0067-0079], teaches the limitation of claim 23 at paragraphs [0051-0053], teaches the limitation of claims 24 at paragraph [0054], teaches the limitation of claim 25 at paragraph [0055], teaches the limitations of claims 26-29 at paragraphs [0058-0059], teaches the limitations of claims 31-36 at paragraphs [0080-0082], teaches the limitations of claims 37-43 at paragraphs [0089-0091], teaches the

limitations of claims 44-46 at paragraph [0094], teaches the limitations of claims 52-54 at paragraphs [0216-0232], teaches the limitation of claim 60 at paragraph [0096], teaches the limitations of claims 56-58 at paragraphs [0097], teaches the limitations of claims 55-56 at paragraphs [0253]. The difference between WO document and instant application is WO document does not teach oxidizing oil-in-water emulsion and claimed fatty alcohol.

Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under (f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is 3-5. See examples for additives.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of 'WO document using having oxidizing agent, surfactant, stabilizer, amphiphilic polymer of formula I and hydrophobic unit and combine it with fatty alcohol expecting beneficial effect. One of ordinary skill in the hair care art would be motivated to prepare the compositions in the form of cream emulsion with the reasonable expectation of success that it is easier to apply the bleaching compositions in the form cream instead of hydrous as the compositions can be applied onto hair easily and it won't run off and bleaching the hair can be performed effectively. One of ordinary skill in the art would be motivated to add fatty alcohol in emulsions with the reasonable expectation of success that the

viscosity of the emulsions can be controlled by means of fatty alcohol. This is a prima facie case of obviousness.

Claims 1-59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 and 71-80 and 83 of U.S. Patent No. 7,338, 534 ('534) in view of U.S. Patent 4,927, 627 ('627).

Instant application is claiming cosmetic composition for treating keratin fibers using amphiphilic polymer and oxidizing agent, fatty alcohol and surfactant in the form of emulsions and the claims in the patent are to oxidation dye composition for keratin fibers using the same amphiphilic copolymers and surfactant and oxidation dye. Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under (f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is 3-5. See examples for additives.

Accordingly it would obvious to one of ordinary skill in the art at the time the invention was made to prepare the compositions of patent and combine it with oxidizing agent and fatty alcohol and use the compositions in the form of emulsion taught by patent '627 for bleaching the hair.

Although patent '534 include an additional requirement, i.e., oxidation dye, the use of the claim language "comprising" permits these additional requirements. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not exclude additional, unrecited elements or method steps. See, e.g., Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). Invitrogen Corp. v. BiocrestMfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501,42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.). Using the transitional phrase "consisting of" excludes any element, step, or ingredient not ~specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448,450 (Bd. App. 1948).

The provisional double patenting rejection of claims 1-59 over claims of the co-pending application 10/451,409 is maintained.

Response to Arguments

Applicant's arguments filed 1/9/08 have been fully considered but they are not persuasive.

Applicant's argues:

“Applicant also notes that M.P.E.P. § 804 addresses the situation of two co- pending applications. The section indicates that "[t]he "provisional"

double patenting rejection should continue to be made by the examiner in each application ... unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent." Applicant submits that in view of the foregoing remarks, the provisional double patenting rejection would be the only rejection remaining in this application. For at least this additional reason, Applicant requests that any resolution in the form of submission of a Terminal Disclaimer, if necessary, be deferred".

In response to the above argument co-pending application is not allowed and in the instant application and co-pending application, provisional double patenting rejection is not the only rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619